



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/373,658	08/13/1999	Luisa Inuela-Arispe	1448.1070006	2817

7590

12/04/2001

STERNE KESSLER GOLDSTEIN & FOX PLLC  
SUITE 600  
1100 NEW YORK AVENUE NW  
WASHINGTON, DC 20005-3934

EXAMINER

CANELLA, KAREN A

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 12/04/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/373,658

Applicant(s)  
Iruela-Arispe et al

Examiner  
Karen Canella

Art Unit  
1642



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 months MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 24-85 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-37 and 46-68 is/are allowed.
- 6) ☒ Claim(s) 38-45 and 69-85 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

*Response to Amendment*

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.
2. Claims 38, 46, 47, 67, 68 and 69 have been amended. Claims 24-56 and 67-85 are under consideration.

*Claim Rejections Maintained*

3. The rejection of claims 38-45, 69-85 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for polynucleotides comprising SEQ ID NO:1 and 126 and polynucleotides encoding SEQ ID NO:2 and 125 as well as polynucleotides fully complementary to polynucleotides comprising SEQ ID NO:1 and 126 and polynucleotides which are fully complementary to the polynucleotides encoding SEQ ID NO:2 and 125, does not reasonably provide enablement for polynucleotides which hybridize to SEQ ID NO:1 or SEQ ID NO:126, or polynucleotides which are less than fully complementary to SEQ ID NO:1 or SEQ ID NO:126, or polynucleotides which are less than fully complementary to the polynucleotides encoding SEQ ID NO:2 or SEQ ID NO:125, or polynucleotides which are at least 95% identical to polynucleotides comprising SEQ ID NO:1 or SEQ ID NO:126. Claims 38 and 69 have been amended to recite polynucleotides at least 30 nucleotides in length in order to direct the hybridization claims to read on probes for the disclosed sequences. However, this language still reads on much larger probes, such as cosmids, that could hybridize to the disclosed SEQ ID NO. Amendments of the claims to read on polynucleotides **consisting** of 30 nucleotide residues would help overcome this rejection. Further, claims 77-85 persist in reading on sequences which are 95% identical to the disclosed sequences. Applicant argues that the 95% sequence identity is the only structural requirement necessary for the skilled artisan to envision all of the polynucleotides embodied by the claim. However, 95% sequence identity does not suffice to enable these variants for the reasons stated in the office action of Paper No. 16.
4. All other rejections and objections as stated in Paper No. 16 are withdrawn.


***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Canella whose telephone number is (703) 308-8362. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Karen A. Canella, Ph.D.  
Patent Examiner, Group 1642  
December 3, 2001

  
ANTHONY C. CAPUTA  
SUPERVISORY PATENT EXAMINER  
TECHNICAL CENTER 1800